

Applicant: DONG *et al.*
Serial No.: 10/537,794
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REMARKS

Claims 1-8 are pending.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner rejected claim 5 as allegedly failing to satisfy the written description requirement. The Examiner asserted that a main motor further including two motors that are arranged between the left or right driving wheels and the differential gear, respectively, with the main motor arranged on another drive shaft, is not described in the specification or drawing.

Applicants respectfully disagree with the Examiner. Claim 5 does not fail to satisfy the written description requirement.

The written description requirement is satisfied where an invention is described in sufficient detail such that a person of ordinary skill in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). The disclosure should reasonably convey to a person of ordinary skill in the art that the inventor had possession of the subject matter in question. *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996). If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, then the written description requirement is met even if every nuance of the claims is not explicitly described in the specification; the Examiner's burden is to provide reasons why a person of ordinary skill in the art would not consider the description sufficient. *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996). The Examiner has the burden of presenting evidence or reasons why a person of ordinary skill in the art would not recognize that the written description provides support for the claims. *Revised Interim Guidelines for Examination of Patent Applications Under 35 U.S.C. § 112, Paragraph 1*, 64 FR 71427.

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First, Applicants submit that the Examiner has not made a *prima facie* case for failure of the written description requirement, because the Examiner has not presented any evidence or reasons why a person of ordinary skill in the art would not recognize that the written description provides support for the rejected claim beyond merely asserting that the recited main motor is not described in the specification or any drawing. Second, regardless of whether the Examiner has articulated a *prima facie* rejection, the application as filed provides sufficient written description to support the recited motor of claim 5.

A claim can provide adequate written description for itself. *In re Garnder*, 178 USQP 149 (CCPA 1973). Applicants submit that claim 5 provides adequate written description, as read by a person of ordinary skill in the art, for the claimed subject matter. For example, U.S. Patent No. 5,927,417 to Brunner (“Brunner”), cited in the Notice of References Cited, discloses dual motors for driving two rear wheels of a motor vehicle (see Brunner at features 4 and 14 of the figures, and col. 4, lines 28-33). Accordingly, Applicants request reconsideration and withdrawal of the rejection of claim 5.

REJECTIONS UNDER 35 U.S.C. § 102(B)

The Examiner rejected claims 1-4 and 6-8 as allegedly anticipated by U.S. Patent No. 5,722,502 to Kubo (“Kubo”).

Applicants submit that Kubo does not anticipate the pending claims. Anticipation requires that a single reference disclose each and every element of the claim, *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), explicitly or inherently, and that the reference must disclose the elements arranged as in the claim, *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

Applicants submit that Kubo does not anticipate the presently pending claims because Kubo does not disclose each and every element of the present claims. For

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example, Kubo does not disclose the step transmission of claim 1. Instead, Kubo discloses a torque distributing mechanism 38 (see Kubo, col. 8, lines 64-66) that is preferably a differential distributing mechanism such as a differential gear. Thus, the differential gear of Kubo is not the same as the stepped transmission recited in claim 1.

Further, the features of the dual motors of claim 1 differ from the Kubo disclosure. For example, Kubo discloses that one output shaft (Kubo, 38b) of the torque distributing mechanism (Kubo, 38) is connected to the rotor shaft of the generator (Kubo, 24) and the other output shaft (Kubo, 38c) of the torque distributing mechanism (Kubo, 38) is connected to the rotor shaft of the motor (Kubo, 10) (see Kubo, col. 8, lines 50-53). In contrast, claim 1 recites that the rotor shaft of the main motor is connected to the output shaft of the stepped transmission, and the rotor shaft of the auxiliary motor is connected to the output shaft of the ICE by a drive mechanism. Thus, claim 1 recites a stepped transmission and drive mechanism that are different and that achieve different functions.

Kubo does not disclose that when transmission shifting occurs shifting works in auxiliary driving mode, in which the main motor drives the vehicle auxiliary during shifting (see claim 1, paragraph d). As a result, since power transfer from the engine to the wheel is temporarily cut off for a vehicle with stepped transmission during shifting, the hybrid vehicle of instant claim 1 comprising a stepped transmission prevents power transfer cut off by the main motor driving the vehicle when the stepped transmission is shifting. Because Kubo lacks the stepped transmission, this feature of the rejected claim cannot be achieved by Kubo's vehicle. Kubo does not disclose at least feature (d) of claim 1, and so does not anticipate claim 1.

Kubo does not disclose that when the vehicle is under normal driving conditions, the system works in normal running mode wherein the internal combustion engine drives the vehicle independently (see claim 1, paragraph f). In this mode, the vehicle is driven only by the engine through the stepped transmission when the vehicle is in normal driving condition in which the engine works in the region of high efficiency. In such a

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mode, the main motor does not work. See, for example, the instant specification at Fig. 4g and Fig. 4f. In contrast, Kubo discloses a controller for determining a control mode from multiple control modes, including an SHV mode, a continuous-type PSHV mode and PEV mode. A clutch (Kubo, 36) provided between the torque distributing mechanism (Kubo, 38) and the motor (Kubo, 10) is a characteristic component member to achieve the switching between the SHV mode and the continuous-type PSHV mode. Kubo also discloses detail operation for the continuous-type PSHV mode and the SHV mode (see Kubo, col. 13). Kubo discloses that in the PSHV mode, when the shaft lever is in drive position, the motor (Kubo, 10) is always supplied with electricity to drive the output shaft (Kubo, 38c). When the continuous-type PSHV mode is switched to the SHV mode by releasing the clutch (Kubo, 36), the output shaft (Kubo, 38c) is also always driven by the motor. Thus, Kubo does not disclose at least feature (f) of claim 1, and so does not anticipate claim 1.

Further, the Kubo clutch (Kubo, 36) differs from the "clutch" recited in rejected claim 1. Kubo discloses a clutch provided between the torque distributing mechanism (Kubo, 38) and the motor (Kubo, 10), wherein the function of the clutch (Kubo, 36) is to switch the operation modes of SHV and PSHV. In contrast, the instant specification provides a "clutch" before the stepped transmission that corresponds to a conventional vehicle with a stepped transmission. Thus, Kubo does not disclose the "clutch" of rejected claim 1, and so does not anticipate claim 1.

Applicants submit that the rejected claims are not anticipated by the cited reference, nor does the cited reference render the pending claims obvious. Accordingly, Applicants request allowance of the pending claims.

CONCLUSION

Reconsideration and allowance are respectfully requested.

No fee is believed to be due with respect to the filing of this response. If any fees are due, or an overpayment has been made, please charge, or credit, our Deposit Account

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No. 11-0171 for such sum.

If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicant's attorney at the telephone number provided below.

Respectfully submitted,



Tor Smealand
Registration No.: 43,131
Attorney for Applicants

Kalow & Springut LLP
Telephone No.: (212) 813-1600